

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN E. CALLIS and
EDWARD T. SABOURIN

Appeal No. 96-3431
Application 08/307,535¹

ON BRIEF

Before KIMLIN, SMITH, JOHN, and GARRIS, Administrative Patent
Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

Appeal No. 96-3431
Application No. 08/307,535

This is a decision on an appeal from the final rejection of claims 1 through 36 which are all of the claims in the application.

The subject matter on appeal relates to a fuel composition for two-cycle engines which includes an additive formulation comprising a sulfurized molybdenum-containing composition, a carboxylic acid amide and a succinimide. Further details of this appealed subject matter are set forth in illustrative independent claims 1 and 19, a copy of which taken from the appellants' brief is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

Norman et al. (Norman)	3,219,666	Nov. 23, 1965
Miller	3,405,064	Oct. 8, 1968
King et al. (King)	4,263,152	Apr. 12, 1981

Claims 1 through 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over King, Miller and Norman.²

Appeal No. 96-3431
Application No. 08/307,535

We refer to the briefs and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and the examiner concerning the above noted rejections.

OPINION

For the reasons which follow, we will sustain the above noted rejection.

The appellants argue that "the following limitations in the rejected claims are missing from the cited references and render the claimed subject matter unobvious over those cited references: 1) a fuel composition for two-cycle engines, and 2) a major amount of fuel boiling in the gasoline range" (brief, page 11).

This argument is clearly incorrect. Miller explicitly discloses a fuel composition for two-cycle engines comprising a major amount of fuel boiling in the gasoline range as required by the appealed claims (e.g., see lines 13 through 69 in column 7). Indeed, patentee's fuel composition corresponds to the composition defined by the independent claims on appeal in all respects except that the former does not include the here claimed

Appeal No. 96-3431
Application No. 08/307,535

and detergents (e.g., see lines 1 through 3 in column 8). In this regard, King discloses the here claimed sulfurized molybdenum-containing composition as an antioxidant additive for lubricating oils and, significantly, fuels (e.g., see the abstract, lines 3 through 7 in column 2 as well as lines 5 through 44 and especially line 37 in column 7), and Norman discloses the here claimed succinimide as a detergent additive for lubricants and, significantly, fuel compositions (e.g., see lines 13 through 18 in column 1 and lines 18 through 30 in column 2). These applied reference disclosures evince that it would have been prima facie obvious for one with ordinary skill in the art to provide the fuel composition of Miller with a sulfurized molybdenum-containing composition and a succinimide in order to obtain the oxidation-inhibiting and detergent properties desired by patentee via additives shown by King and Norman to be known in the prior art as supplying such properties.

According to the appellants, "it is clear that the references are from non-analogous art", and "[a]s neither Norman

Appeal No. 96-3431
Application No. 08/307,535

The Miller reference is undeniably within the field of the appellants' endeavor whereas the King and Norman references are at least reasonably pertinent to the particular problem with which the appellants were involved. It follows that none of these references can be characterized as being from a non-analogous art. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). Moreover, we are convinced that an artisan with ordinary skill would have been motivated to effect the above discussed combination of the applied prior art in order to obtain the oxidation-inhibiting and detergent benefits desired by Miller and respectively supplied by the King and Norman additives based upon a reasonable expectation of success. In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988).

It is the appellants' further contention that, "even if the cited references did establish a prima facie case of obviousness, the results in Example 6 of the present specification are clearly sufficient to rebut the prima facie case" (brief, page 17). However, the data of Example 6 possess numerous deficiencies

Appeal No. 96-3431
Application No. 08/307,535

the Example 6 evidence involves only three specific inventive compositions, it is considerably more narrow in scope than the independent claims on appeal, and it is well established that evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims to which it pertains. In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979). Finally, it appears to us that the reduction of engine deposits (i.e., cleanliness) and concomitant piston ring sticking shown in Example 6 would have been expected and thus obvious, rather than unexpected and thus nonobvious, in light of Miller's express teaching that his composition effects such a reduction (e.g., see lines 19 through 40 in column 1 and particularly lines 13 through 39 in column 7). In re Skoll, 523 F.2d 1392, 1396-97, 187 USPQ 481, 484 (CCPA 1975).

Under the circumstances recounted above, it is our ultimate determination that all the evidence of record, on balance, weighs most heavily in favor of an obviousness conclusion. We shall sustain, therefore, the examiner's section 103 rejection of

Appeal No. 96-3431
Application No. 08/307,535

No time period for taking any subsequent action in
connection with this appeal may be extended under
37 CFR § 1.136(a).

AFFIRMED

Edward C. Kimlin)	
Administrative Patent Judge)	
)	
)	
)	
John D. Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Bradley R. Garris)	
Administrative Patent Judge)	

tdc

Appeal No. 96-3431
Application No. 08/307,535

Chevron Corp
Law Dept.
Patent and Licensing Unit
P.O. Box 7141
San Francisco CA 94120-7141

